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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Savane International Corp.¹

Serial No. 75/497,959

Edward M. Prince of Alston & Bird LLP for Savane
International Corp.

Catherine K. Krebs, Trademark Examining Attorney, Law
Office 108 (David Shallant, Managing Attorney).

Before Hanak, Hairston and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On June 8, 1998, Savane International Corp (applicant)
filed an application² to register the following mark on the
Principal Register for goods ultimately identified as
"slacks, jeans, shorts, shirts, skirts, socks, knit tops,

¹ The application was originally filed in the name of Farah
Incorporated who subsequently changed its name to Savane
International Corporation. See Reel 1874, Frame 0558.

² Serial No. 75/497,959. The application contained an allegation
of applicant's bona fide intent to use the mark in commerce.

knit bottoms, dresses, jackets, vests, belts and hats sold through department stores and discount stores" in International Class 25:



The Examining Attorney³ ultimately refused to register the mark because the examining attorney held that there is a likelihood of confusion between applicant's mark for its goods and the marks shown below for, inter alia, "clothing, namely, shirts, T-shirts, sweatshirts, baseball caps, socks and jackets" in International Class 25.

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³ The present examining attorney was not the original examining attorney in this case.

⁴ Registration No. 2,142,729, issued March 10, 1998.

⁵ Registration No. 2,142,730, issued March 10, 1998.

Both marks are owned by the same entity and the identification of goods is the same for both registrations.

After the Examining Attorney made the refusal final, this appeal followed. Both applicant and the examining attorney filed briefs. An oral hearing was held on March 6, 2002.

The Examining Attorney determined that when the marks are compared in their entireties, there is a likelihood of confusion. The examining attorney held that the cited registrations and applicant's mark "can all be vocalized as 'one eighty.'" Brief at 4. She noted that the background designs of the applicant's mark and Registration No. 2,142,729 were simple geometric shapes and "of diminished trademark significance." Id. As to the goods, the examining attorney considered the fact that the applicant limited its goods to those sold through department stores and discount stores," but she pointed out that registrant's identification of goods is not limited to any specific channels of trade. Therefore, the examining attorney determined that the goods are otherwise identical (shirts, socks, and jackets) or closely related, and that there is a likelihood of confusion.

Applicant, on the other hand, "contends that the marks are essentially visual marks which, when viewed in their

entireties, are distinctly different." Reply Br. at 2-3. In addition, applicant argues that the Office has registered three other marks that contain the designation 180 and therefore, the registered "mark is entitled to a narrow scope of protection." Brief at 10. Applicant also argues that because the entity that owns the cited registrations is apparently a religious organization the trade channels would not be similar.

We affirm the refusal to register under Section 2(d).

Determining whether there is a likelihood of confusion requires consideration of the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first factor we consider is whether the goods are related. In this case, the goods are, at least in part, identical (shirts, socks, and jackets). Even applicant

admits that "the goods cover shirts, therefore, for purpose of this appeal it is assumed that the goods are identical." Brief at 9. Therefore, we must consider that both applicant and registrant use the marks on the identical goods, i.e., shirts, jackets, and socks. See Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). See also Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"); In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997)(quotation marks omitted) ("Indeed, the second DuPont factor expressly mandates consideration of the similarity or dissimilarity of the services as described in an application or registration").

Therefore, we must presume that the goods move through all normal channels of trade for such products. Applicant argues that we "cannot ignore the other information provided by the registration certificate. First, the [registrant] is Willie George Ministries, Inc. Applicant knows of no ministry engaged in the manufacture and sale of clothing through department stores and discount stores." Appeal Brief at 9. First, to the extent that applicant's brief contains argument about the marketing of clothing items by religious groups, it is simply argument of counsel and it is unsupported by the record. Therefore, we will not consider this "evidence." Second, if we are being asked to read limitations into the identification of goods based on assumptions drawn from the name of the registrant, we decline to do so. We are constrained to consider the issue of likelihood of confusion based on the goods identified in the application and registration. See Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation here, and nothing in the inherent nature of Squitco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The board, thus, improperly read limitations into the registration"). Similarly, nothing in registrant's marks or identification of goods prohibits the

sale of registrant's goods in department or discount stores. While applicant has limited its channels of trade, the registrant's identification of goods is not limited. If applicant believes that the identification of goods should be limited, it may file a petition to cancel in which it may seek to "modify the ... registration by limiting the goods or services specified therein." 15 U.S.C. § 1068. Therefore, we find that applicant's and registrant's goods are, in part, identical, and we can presume that these identical goods pass through channels of trade that are also at least overlapping to the extent that they involve department and discount stores and that they would be encountered by the same potential purchasers.

Next, we consider whether the marks are similar in sound, appearance, meaning or commercial impression. du Pont, 177 USPQ at 567. Both marks contain words or numerals that could be considered to be the expression "one eighty." Applicant uses the number "180," while registrant's marks contain the word "oneighty" ('729) and the word "oneighty" with the numerals 1, 8, and 0 ('730). Even applicant admits that "[I]f the marks were deciphered correctly, they could be pronounced as '180.'" Response dated August 28, 2000, p. 3. While applicant uses numerals and registrant uses a phonetic equivalent of the same

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numerals with a slight misspelling, this fact does not result in any significant differences in the parts of the marks that can be spoken. In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) ("There is little room to debate the similarity between ROPELOCK and ROPELOK in appearance"). Here, the registered marks are likely to be verbalized as "one eighty" and therefore the spoken portion of the marks would be pronounced identically. The only differences between the marks consist of their designs. Applicant's mark contains a circle design with a degree symbol while registrant's marks contain an oval design ('729) or stylized numbers ('730). The differences in the design elements do not overcome the other similarities of the marks. We acknowledge that the marks are not identical although that, of course, does not end the likelihood of confusion analysis. It is well settled that it is improper to dissect a mark. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). However, more or less weight may be given to a particular feature of a mark for rational reasons. In re National Data Corporation, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

When we compare marks, "[s]ide-by-side comparison is not the test. The focus must be on the 'general

recollection' reasonably produced by appellant's mark and a comparison of appellee's mark therewith." Johann Maria Farina Gegenuber Dem Julichs-Platz v. Chesebrough-Pond, Inc., 470 F.2d 1385, 176 USPQ 199, 200 (CCPA 1972) (citation omitted). The fact that applicant's mark is depicted in numerals and registrant's marks contain a telescoped word that stand for the same numerals is not significant. In a similar case, the Board held that the mark for the words "THIRTY, FORTY, FIFTY" for cold cream was confusingly similar to the registered mark for the numerals "60 40 20" for conditioning skin cleanser. Richardson-Vicks Inc. v. Franklin Mint Corp., 216 USPQ 989 (TTAB 1982). The Board found that "the fallibility of the human memory over a period of time" supported the conclusion that confusion was likely. Id. at 992. See also Clorox Company v. State Chemical Mfg. Co., 197 USPQ 840, 844 (TTAB 1977) ("[T]aking into account, as we must, the fallibility of the human memory over a period of time, we conclude that applicant's mark 'FORMULA 999' so resembles opposer's mark 'FORMULA 409' as to be likely" to cause confusion). Here, we take into consideration the facts that applicant's mark is composed of numerals, a degree-like symbol, and a circular design. On the other hand, both registered marks contain the telescoped word

equivalent of the applicant's 180 numerals. One mark contains an oval design, while the other registration contains stylized characters that appear to be the numbers 1, 8, and 0. However, these differences are not sufficient to distinguish the marks. In appropriate cases, a finding of similarity as to any one factor (sight, sound or meaning) alone may be sufficient to support a holding that the marks are confusingly similar." In re White Swan Ltd., 8 USPQ2d 1534, 1535 (TTAB 1988). Here, the marks would be pronounced similarly and would have the same meaning, i.e. 180. "While the appearance of the designs is not identical, we cannot agree that the marks are simply visual marks. They have a spoken component to them that would be used when referring to the goods sold under the marks.

In a similar case, the Federal Circuit has held that there was a likelihood of confusion even where the applicant disclaimed the only wording in the mark, the designs were different, and the services of the parties were not the same. Shell Oil, 26 USPQ2d at 1691 ("RIGHT-A-WAY and design for service station oil and lubrication services confusingly similar to RIGHT-A-WAY and different design for distributorship services in the field of automobile parts). Here, applicant's and registrant's marks contain the same numerical expression and the designs

do not significantly distinguish the marks. Therefore, we find that the marks are similar. Also, the goods in this case are, in part, identical. As a result, we conclude that when these similar marks are used on identical goods, there is a likelihood of confusion.

Reinforcing our conclusion that there is a likelihood of confusion is the fact that several of the goods here are identical. Because the marks would be used on identical clothing items, there is a greater likelihood that when similar marks are eventually used in this situation, confusion would be likely. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) ("When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines").

Applicant makes much of the fact that other registrations exist or had existed for clothing items containing the expression "180."⁶ The weight given to third-party registrations in likelihood of confusion determinations is minimal. "[T]hird party registrations are entitled to little weight in resolving a particular

⁶ Applicant's argument concerning registrations for the number "360" are even less relevant to the issue in this case.

issue of likelihood of confusion because they are insufficient, per se, to establish that the marks shown therein are in use or that the purchasing public is aware of them, nor can their existence aid an applicant in its attempt to register a similar mark for like or related goods if confusion is likely to occur." Clorox Co., 197 USPQ at 844. See also In re Hub Distributing, Inc., 218 USPQ 284, 285 (TTAB 1983) ("[A]bsent evidence of actual use of the marks subject of the third-party registrations, they are entitled to little weight on the question of likelihood of confusion"). Even if the Office may have registered marks that could be considered confusingly similar with the cited registration hardly supports the registration of another confusingly similar mark. In this particular case, one of the marks to which applicant refers (Reg. No. 2,145,497) was cancelled voluntarily shortly after registration. The other two registrations, No. 1,897,011 for the mark 180° ABOVE and a globe and hand design and No. 2,018,327 for the mark 180° FROM ANYWHERE, contain significant other elements not present in applicant's mark. Furthermore, even a weak mark is entitled to protection when marks as similar as applicant's and registrant's are used on the identical goods.

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Finally, even if we had doubts about the issue of likelihood of confusion, we must resolve them against applicant.

If there be doubt on the issue of likelihood of confusion, the familiar rule in trademark cases, which this court has consistently applied since its creation in 1929, is that it must be resolved against the newcomer or in favor of the prior user or registrant. The rule is usually applied in inter partes cases but it applies equally to ex parte rejections.

In re Pneumatiques, Caoutchouc Manufacture et Platitudes Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729 (CCPA 1973). See also Dixie Restaurants, 41 USPQ at 1535 ("Dixie argues alternatively that the PTO should pass the mark to publication and allow the registrant to oppose the applicant's mark, if it chooses. But it is the duty of the PTO and this court to determine whether there is a likelihood of confusion between two marks").

Decision: The Examining Attorney's refusal to register applicant's mark on the ground that it is likely to cause confusion with the cited registrations under Section 2(d) of the Trademark Act is affirmed.